

R E M A R K S

Claims 10, 16, 20, and 23 are amended. Claims 1-9, 11-15, 17-19, 21, and 22 stand as originally filed. Re-examination and reconsideration are requested.

5 In the office action, paper number (unspecified), dated October 11, 2006, the examiner rejected claims 20-22 under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons specified in sections 5-8 of the office action. With regard to the art-based rejections, the examiner rejected claims 10 1-9, 13-15, and 19-22 under 35 U.S.C. §102(b) as being anticipated by the publication of Vines, entitled "How to save your files and your sanity" (Vines). The examiner objected to claims 10-12, 16-18, and 23 as being dependent upon a rejected base claim, but indicated that they would be allowable if 15 rewritten in independent form.

Re the Claims:

Claim 10 is amended to place it in independent form and to include the limitations of the base claim (claim 1) and the intervening claim (claim 9) from which it depends. Claim 10, and 20 the claims depending therefrom (claims 11 and 12) should now be allowable.

Claim 16 is amended to place it in independent form and to include the limitations of the base claim (claim 13) and the intervening claim (claim 15) from which it depends. Claim 16, 25 and the claims depending therefrom (claims 17 and 18) should now be allowable.

Claim 20 is amended to incorporate the suggestion of the patent examiner, thus remove the section 112 issue from claim 20 and the claims depending therefrom (claims 21 and 22).

30 Claim 23 is amended to place it in independent form and to include the limitations of the base claim (claim 19) from which it depends. Claim 23 should now be allowable.

Re the Rejections of Claims 20-22:

The examiner rejected claims 20-22 under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons specified in sections 5-8 of the office action. In response, applicants have amended claim 20 to incorporate the suggestion of the examiner. Consequently, applicants believe that claims 20-22 are sufficiently definite under Section 112, second paragraph.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

Re the Section 102 Rejections:

The examiner rejected claims 1-9, 13-15, and 19-22 under 35 U.S.C. §102(b) as being anticipated by Vines. These rejections are improper in that Vines does not meet the limitations of the rejected claims. Consequently, Vines cannot anticipate any of the rejected claims.

The Vines reference amounts to nothing more than a tutorial on how to save files on a Windows-based operating system. It does not discuss any aspects of a file backup procedure, much less discuss different types of backup devices, backup media, or a media manager. Claim 1 of the present application is directed to a method that comprises "receiving a list of media to be loaded into a plurality of backup devices." In section 11 of the

office action, the examiner asserts that a "list of media" is the "file" of the Vines reference. However, in the context of the Vines reference, is just that, it is a document or other file created by the user that the user desires to save somewhere on the computer. Nowhere does Vines ever disclose, or even suggest, that the "file" could be a "list of media" within the context of the present invention.

Claim 1 also requires "ordering the list by physical location of the backup devices." This limitation is not met by Vines. As already mentioned, Vines is not concerned with data backup procedures, thus does not disclose, or even suggest, a system involving a plurality of backup devices (such as disk or tape drives). While the examiner regards Vines' drives as backup devices, nowhere does Vines disclose or suggest anything about the physical location of the backup devices. Consequently, Vines cannot be said to order a list by the physical location of such backup devices.

Because Vines fails to disclose at least the foregoing elements and limitations of independent claim 1, Vines cannot anticipate claim 1.

Dependent claims 2-9 are at least allowable over Vines because they depend from claim 1, which is allowable over Vines.

* * *

Independent claim 13 is also allowable over Vines because Vines fails to meet several of the elements and limitations contained in claim 13. For example, claim 13 requires a planner that receives a list of media to be loaded into a plurality of backup devices. However, Vines' files are not a list of media within the context of the present invention, nor does Vines even suggest that the files might involve a list of media.

Claim 13 also requires that the planner order the list "by physical location of the backup devices." Vines does not disclose any backup devices at all, much less discuss anything

about the physical locations of such backup devices. While the examiner asserts that Vines' drives might be backup devices, it is unreasonable to make such an assertion in the context of the teachings of the Vines reference. Vines' drives simply represent the device that stores the files in the first place, they are not backup devices within the normal meaning of the term. Because Vines fails to disclose at least these elements and limitations of claim 13, Vines cannot anticipate claim 13.

Dependent claims 14 and 15 are not anticipated by Vines because they depend from claim 13, which is not anticipated by Vines.

* * *

Independent claim 19 is allowable over Vines because Vines does not disclose "receiving a list of media to be loaded into a plurality of backup devices." As mentioned above, it is unreasonable to construe the files of Vines as being "list of media" as contemplated by claim 19. Vines says nothing about backup operations in general and certainly does not disclose anything that could be reasonably construed as a backup device. Claim 19 also requires "ordering the list by physical location of the backup devices." Of course, Vines fails to disclose a backup device, much less issues associated with differing physical locations of such backup devices. Therefore, because Vines fails to disclose at least these elements and limitations of claim 19, Vines cannot anticipate claim 19.

Dependent claims 20-22 are at least allowable over Vines because they depend from claim 19, which is allowable over Vines.

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Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants

respectfully request the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

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